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#10 Response 5/12/94

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. 60831/101/GRJO

In re patent application of
John Grawe
Serial No. 07/914,386
Filed: July 17, 1992
For: ABATEMENT PROCESS FOR CONTAMINANTS

Group Art Unit: 1201
Examiner: D. Springer

RESPONSE TO RESTRICTION REQUIREMENT AND

PETITION FOR EXTENSION OF TIME

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Sir:

Applicant hereby responds to the Restriction Requirement mailed February 23, 1994, the period for response to which has been extended to April 25, 1994 by virtue of the enclosed petition for a one month extension and payment of the required fee. In the Restriction Requirement, the Examiner restricted applicant's claims to eleven inventions. Applicant elects the invention of Group I with traverse.

For a restriction to be proper, the Examiner must demonstrate a serious burden if restriction is not required. MPEP §803. A *prima facie* showing of burden is made if the examiner shows that the inventions are separately classified, have separate status in the art, or require separate search. *Id.* In this case, such a showing has not even been attempted.

Indeed, the Examiner shows that inventions of Groups I to VIII are all classified in 134/006 and the invention of Group XI is classified in 134/008 (the classifications of Groups IX and X are not provided). Moreover, according to an APS computer search, class 134, subclass 006 apparently contains only 528 original and cross-referenced patents. Further, according to DIALOG, class 134, subclass 008 contains only 122 patents which

are not originally classified in subclass 006. Accordingly, no undue burden is created by the additional inventions.

Further still, all of Groups II-V are dependent upon the independent claim of Group I. Hence, if independent claim 1 is allowable, then dependent claims 2-21 are *per se* allowable.

The restriction is further not understood since the Examiner already has issued a first action on the merits against all of the claims after a search was conducted. MPEP §704. Why is a restriction necessary after the Examiner already has searched against all of the claims?

Applicant is an individual with very limited financial resources. This onerous restriction requirement requiring expenditure of thousands of dollars in further filing fees and prosecution costs is manifestly unfair, especially since applicant already has spent a considerable sum of money extensively responding to the first Official Action.

Accordingly, applicant requests reconsideration and withdrawal of the requirement, so that such an onerous and unwarranted financial burden will be unnecessary. Indeed, given (i) the incredible financial burden, (ii) the demonstrated lack of burden on the Examiner, (iii) the Examiner's previous prior search and Office Action against all of the claims, and (iv) the present stage of prosecution, the Examiner will leave applicant no choice but to petition the Commissioner should the requirement be maintained.

In sum, having already shown the pending claims to be clearly distinguishable over the prior-cited references, applicant respectfully requests withdrawal of the Restriction Requirement and issuance of a Notice of Allowance without further delay.

Applicant expressly petitions for a one-month extension of time to respond to the February 23, 1994 Restriction Requirement. A check for the extension fee is attached. It is believed that no additional fees are required; however, if any additional extensions of time are required for this response, applicant expressly petitions for such extension(s), and hereby authorizes the Commissioner to charge the necessary fee to Deposit Account No. 19-0741.

Respectfully submitted,

4/25/94
Date

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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner of Patent and Trademarks Washington, D.C 20231 on 4/25/93
(Date)

Celeste Holmes
(Signature)